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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,767	04/07/2005	Rajinder Singh	02-438-B1	9966
20306 7590 11/14/2008 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
CHU, YONG LIANG				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,767

Applicant(s)

SINGH ET AL.

Examiner

YONG CHU

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25, 28-34 and 38-46 is/are pending in the application.
- 4a) Of the above claim(s) 30-34 and 38-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 28, 29 and 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

Claims 25, 28-34, and 38-46 are pending in this application. Claims 30-34 and 38-41 remain withdrawn as non-elected subject matter. Claims 25, 28-29 and 42-46 are under examination on the merits.

Information Disclosure Statement

Applicants' Information Disclosure Statement, filed 08/14/2008 has been considered. Please refer to Applicant's copy of the PTO-1449 submitted herewith.

Response to Arguments

Claim rejections under 35 U.S.C. §102(b)

Applicants' argument over the rejection of claims 25, 28-29, and 42-46 under 102b on inherent anticipation over the Peakdale catalog in view of the Wabnitz reference as inherency has been considered, and is found not persuasive. Based on the information provided to the Office by Peakdale company, the cited Compound 281 was commercialized by the company for use of drug screening, and other screening purpose. Even as Applicants argued, this compound can be used as perfume, or air-fresher, this compound would still be formulated with other diluents such as water. Therefore, a compound used for screening purpose has inherent property as a composition comprising the Compound 281 and a diluent. Therefore, claims 25, 28-29, and 42-46 are anticipated by the teachings of the Peakdale catalog/communication. Applicants' argument that the Wabnitz reference does not teach that the

Peakdale catalog discloses compounds in a buffer solution is not persuasive.

The cited Wabnitz reference teaches that a compound in drug screening has to be dissolved in a buffer as a common practice required by current technologies for drug screening, because a compound in solution form is needed to interact with bio-macro molecules, cells or organism for drug screening purpose.

Therefore, the rejection is maintained.

Applicants' argument over the rejection of claims 25, 28-29, and 42-46 under 102b over the '630 patent on the ground that **R³³** as presently claimed as **not substituted** C₁₋₃ alkyl, while the '630 compound is a dimethyl amine substituted alkyl is found persuasive. Therefore, the rejection is withdrawn.

Claim rejections under 35 U.S.C. §103(a)

Applicants' argument over the rejection of claims 25, 28-29, and 42-46 under 103a over the '630 patent on the ground that **R³³** as presently claimed as **not substituted** C₁₋₃ alkyl, while the '630 compound is a dimethyl amine substituted alkyl is found persuasive. Therefore, the rejection is withdrawn.

Applicants' argued that the **Peakdale** communication only stated that Compound 281 was part of a family of compounds manufactured for **screening purposes**. Applicants further argue that no utility or potential utility was disclosed or suggested for the compound in the Peakdale catalog (communication), and the screening purpose could be for use in a perfume or air-freshener application, not support for Office's allegation for drug screening purpose(s). Applicants' arguments have been fully considered but found not persuasive. The instantly

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rejected claims are drawn to a composition comprising a pharmaceutically acceptable carrier, excipients, or diluent together with a known compound (i.e. the Compound 281). According to a dictionary, in chemistry, a diluent is an inert substance used to dilute. Water is a diluent. The Compound 281 was taught to be used for screening purpose from Peakdale catalog as being acknowledged by Applicants, and such screening purpose could be used in perfume or air-freshener application as being suggested by Applicants. Even the instantly claimed composition is used for perfume, the prior art still renders the instantly claimed composition obvious because the two limitations of the claimed composition as the active compound (i.e. Compound 281) and a diluent (e.g. water) are taught and suggested in the combined teachings from the cited references. Applicants argue that the claimed composition has anti-HCV activity. However, such a limitation is not a claimed limitation, and is not reflected in the claims. Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim the limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). Furthermore, even this "anti-HCV activity" preamble had been included in the claims, the prior arts might still render the instant claims obvious due to "objective reach of the claim". In addition, to one of ordinary skills in the art, a compound has utility for screening purpose is a broad utility, and includes a utility

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for pharmaceutical drug screening purpose; see a *Google search under terms "indole compound, screening"* leads to many pharmaceutical formulations.

Therefore, the rejection is maintained.

Conclusion

- No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Status information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

/Yong Chu/
Patent Examiner
Art Unit 1626

/Kamal Saeed/
Primary Patent Examiner
Art Unit 1626